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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,674	03/23/2001	Beat Muller	CL/V-31362A	5772

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CIBA VISION CORPORATION
PATENT DEPARTMENT
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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,674

Applicant(s)

MULLER ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/10/04 & 05/19/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/10/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/10/04 has been entered.

Information Disclosure Statement

2. A copy of page 1 of the information disclosure statement filed 08/10/01, indicating that item "AR" has been considered and initialed, is herein attached to the Office Action. An apology is extended to applicant for any inconvenience that this may have caused.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

4. Claims 1-3 & 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "reacting an organic compound having an ethylenically unsaturated group and a group which reacts with said functionality introduced by the chain transfer agent in step (a)" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to what the exact reactants are, i.e., it not clear as to what the organic compound is being reacted with, i.e., functional groups on the copolymer or other. Applicant's comments are welcomed.

B) The recited "according to any one of claims 1 to 6" per claim 8 constitutes indefinite subject matter as per such including claim 4 which engenders the dependency of claim 8/4 (cancelled claim), improper.

C) The recited "unsubstituted" per claim 5 is misspelled. It is suggested that applicant replace such with "unsubstituted" so as to correct an obvious typographical error.

Art Unit: 1713

D) The recited "wherein the copolymer of step (a)" per claim, 9 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.

E) The recited "R14, and R15 are each independently of the other hydrogen" per claim 9 engenders awkwardly expressed claim language. It is suggested that applicant adopt the following language: "---R14 and R15 are each, independently of the other, hydrogen---".

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no support can be found for the limitation "wherein Y is C1-C124-alkyl which is substituted by hydroxyl" per claim 2 and this, as such, engenders a New Matter situation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

Art Unit: 1713

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 & 5-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious over Valint, Jr. et al (U.S. 5,981,669) or Valint, Jr. et al (U.S. 5,981,675).

Valint, Jr. et al'669 teach silicone compositions, useful in forming contact lens material, which are the polymerization product of a mixture of (A) a hydroxyl- or amino-terminated prepolymer prepared by reacting (a) 60 to 95 mole % of an ethylenically unsaturated silicon-containing monomer, (b) 2.5 to 20 mole % of an ethylenically unsaturated monomer containing a hydroxyl or amino radical, (c) 2.5 to 20 mole % of a chain transfer agent that provides the prepolymer with hydroxyl- or amino-functional radicals and (d) 0 to 20 mole % of an ethylenically unsaturated monomer other than monomers (a)-(d) and (B) at least one monomer reactive with hydroxyl- or amino-functional radicals of the prepolymer. See, the Abstract, col. 2, lines 8-67 and cols. 3-5 of Valint, Jr. et al'669.

Valint, Jr. et al'675 teach siloxane macromonomer comprising the polymerization product of a mixture of (A) a macromonomer (X)(E)_n wherein X is derived from a copolymer prepared by reacting at least 50 mole % of an ethylenically unsaturated silicon-containing monomer, 2.5 to 20 mole % of an ethylenically unsaturated monomer containing a hydroxyl, amino or carboxylic acid radical, 2.5 to 20 mole % of a chain transfer agent and 0 to 15 mole % of an ethylenically unsaturated monomer, E is a polymerizable, ethylenically unsaturated radical. n = at least 2 and (B) an ethylenically unsaturated silicone-containing monomer. See the Abstract and cols. 2-9 of Valint, Jr. et al'675.

Each of Valint, Jr. et al'669 and Valint, Jr. et al'675 therefore anticipate the instantly claimed invention with the understanding that the silicone-containing prepolymers and macromonomers overlap in scope with the claimed prepolymer.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as

provided for under the guise of In re Best, 195 USPQ 430, 433(CCPA 1977); In re Fitzgerald et al, 205 USPQ 594.

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 289.

Even if it turns out that the claimed invention is not anticipated, it would have been obvious to the skilled artisan to extrapolate, from the disclosures of patentees, the precisely defined prepolymer, as claimed, as per such having been within the purview of the general disclosures of patentees and with a reasonable expectation of success.

As to the dependent claims, the limitations are either taught, suggested or would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Response to Arguments

9. Applicant's arguments with respect to claims 1-3 & 5-9 have been considered and are sufficient to remove the rejection under 35 USC § 112, First Paragraph, as applied to claims 1-3 & 5-9 and the rejection under 35 USC § 112, Second Paragraph as applied to claims 1-3 & 5-9. However, said arguments do not address the merits of the rejection raised supra.

Conclusion

Art Unit: 1713

10. The prior art to McGee et al (U.S. 5,336,797), McGee et al (U.S. 5,387,663) and McGee et al (U.S. 5,563,184), listed on the attached FORM PTO 892, is cited as of interest in teaching siloxane macromonomers and considered merely cumulative to the prior art supra.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
02/22/05